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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,666	08/01/2006	Brian John Higgins	4623-053150	3792

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EXAMINER
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SMITH, NKEISHA

ART UNIT	PAPER NUMBER
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3632

NOTIFICATION DATE	DELIVERY MODE
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06/02/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@webblaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,666	<b>Applicant(s)</b> HIGGINS, BRIAN JOHN	
	<b>Examiner</b> NKEISHA SMITH	<b>Art Unit</b> 3632	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7,9,11-29,31 and 33-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,9,11-29,31 and 33-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/17/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/2011</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following correspondence is a Final Office Action for application no. 10/553,666 for a GUTTER AND MOUNTING DEVICE FOR BUILDING, filed on 10/17/2005. This correspondence is in response to applicant's reply filed on 3/14/2011. Claims 7, 9, 11-29, 31 and 33-37 are pending.

#### ***Priority***

2. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.
3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 7, 9, 11-24, 27, 28, 31, 33 and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 7 and 16 recite the limitation "the internal wall" therein. There is insufficient antecedent basis for this limitation in the claim. All claims depending therefrom are rejected for the same reasons as being dependent on claims 7 and 16.

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7. Claim 16 recites the limitation "the mounting portion" therein. There is insufficient antecedent basis for this limitation in the claim. All claims depending therefrom are rejected for the same reasons as being dependent on claim 16.

8. Claim 35 recites the limitation "the gutter mounting section" therein. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 16, 18-20, 22, 24-26, 28, 29 and 34-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasscock (U.S. Pat. 3,864,882).

Regarding claim 16, as best understood, Lasscock teaches a gutter (35) and mounting device (20) for buildings, the gutter comprising a generally channel or trough shaped body for collecting water with an inner wall (36) having a gutter mounting thereon, and the gutter extending in a first longitudinal direction, the mounting device comprising an elongated device body that extends in a second longitudinal direction between opposite ends, the body including: a generally U-shaped portion having first (21) and second (28) spaced apart legs having opposing surfaces defining a recess therebetween for closely receiving part of the inner wall of the gutter in an installed position, the first leg of the U-shaped portion including a plurality of gutter retaining clips (22) spaced apart from one another in the second longitudinal direction and extending

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into the recess, the inner wall of the gutter and the U-shaped portion being configured so that when the gutter is located in the installed position, opposite surfaces (front and back) of the inner wall of the gutter are in facing relation with respective ones of the opposing surfaces of the first and second legs and the retaining clips and the second leg of the U-shaped portion bear against the inner wall of the gutter so as to capture the inner wall within the recess to retain the gutter to the mounting device; wherein the mounting device is configured such that when the gutter is in the installed position, the second longitudinal direction of the elongated device body is substantially parallel to the first longitudinal direction of the gutter.

Regarding claim 18, Lasscock teaches the gutter and device of claim 16, wherein the gutter retaining clips include projections which extend into the recess and are adapted to cooperate with the gutter mounting on the inner wall of the gutter.

Regarding claim 19, Lasscock teaches the gutter and device of claim 18, wherein the gutter mounting on the inner wall of the gutter is a raised elongated rib or turned over edge (38, 39) which, when the gutter is in the installed position, is disposed within the recess and inhibited from removal by said projections (Fig. 2).

Regarding claim 20, Lasscock teaches the gutter and device of claim 18, wherein said projections are hook-like elements pressed or punched out of the first leg. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 22, as best understood, Lasscock teaches the device of claim 16, wherein the retaining clips are aligned parallel with respect to a single edge of the

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mounting device (the clips are parallel to both the longitudinal and latitudinal perimeter edges of the device).

Regarding claim 24, Lasscock teaches the gutter and device of claim 16, wherein the body is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 25, Lasscock teaches a method of installing a gutter that extends in a first longitudinal direction, comprising the steps of: attaching a mounting device to a generally planar surface of a building (10), the mounting device comprising an elongated device body including a generally U-shaped portion having first (21) and second (28) legs, the legs of the U-shaped portion being spaced apart so as to provide a recess therebetween for closely receiving part of the gutter (39) with opposite surfaces of the part of the gutter (opposite faces of member 36) being in facing relation with respective legs of the U-shaped portion, the body extending in a second longitudinal direction between opposite ends and including a plurality of retaining clips on the first leg that extend into the recess, the mounting device being positioned on the building so that the U-shaped portion is disposed adjacent to the surface of the building and the mounting device is aligned so as to correspond to an angle of a fall required when the gutter is in an installed position; and mounting the gutter to the device by moving the gutter to the installed position where an inner wall of the gutter (36) extends into the recess, wherein the retaining clips on the first leg and the second leg bear against the inner wall of the gutter so as to capture the mounting portion in the recess so as to retain the gutter in the installed position, when in the installed position, the first

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longitudinal direction of the gutter is substantially parallel to the second longitudinal direction of the elongated device body.

Regarding claim 26, Lasscock teaches the method of claim 25, wherein the retaining clips of the mounting device are parallel with respect to a single edge of the mounting device, and the step of attaching the mounting device to the building further comprises locating the single edge of the mounting device at an angle to an edge of the building so as to correspond to the fall required when the gutter is in the installed position (by virtue of aligning the gutter and clips to the building).

Regarding claims 28, 29 and 36, as best understood, Lasscock teaches the device of claim 16 and the method of claim 25, wherein at least two retaining clips (plurality of clips) are able to simultaneously engage the gutter to retain the gutter to the mounting device (col. 2, lines 11-18).

Regarding claims 34, Lasscock teaches the method of claim 25, wherein the first leg includes a plurality of access apertures for providing access to the second leg when it is being attached to the building.

Regarding claim 35, as best understood, Lasscock teaches the method of claim 34, wherein the access apertures are provided in the gutter mounting section in an alternating arrangement with the retaining clips (from the top of the device down, the apertures and clips are in an alternating arrangement).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 7, 9, 11-15, 17, 21, 23, 27, 31, 33 and 37 are rejected under 35 U.S.C.

103(a) as being unpatentable over Lasscock (U.S. Pat. 3,864,882).

Regarding claim 7, as best understood, Lasscock teaches a mounting device for a gutter (35) for buildings that extends in a first longitudinal direction, the gutter being of the type having a generally channel or trough shaped body for collecting water and having an inner wall (36), the mounting device (20) comprising an elongated device body that extends in a second longitudinal direction between opposite ends, the body including: a generally U-shaped portion, having first (21) and second (28) spaced apart legs having opposing surfaces defining a recess therebetween for closely receiving part of the inner wall of the gutter in an installed position, the first leg of the U-shaped portion including a plurality of gutter retaining clips (22) spaced apart from one another in the second longitudinal direction and extending into the recess, the second leg of the U-shaped portion being attachable to the building (10), the second leg having opposite surfaces (front and back), one of the opposite surfaces being a rear surface (back) and



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the other of the opposite surfaces being one of the opposing surfaces defining the recess (front) so as to allow for locating of the inner wall of the gutter into the recess into the installed position when the second leg is attached to the building, and when the gutter is located in the installed position, opposite surfaces of the inner wall of the gutter are in facing relation with respective ones of the opposing surfaces of the first and second legs and the retaining clips closely cooperate with the second leg of the U-shaped portion and the inner wall of the gutter to retain the gutter to the mounting device; and wherein the mounting device is configured such that when the gutter is in the installed position, the second longitudinal direction of the elongated device body is substantially parallel to the first longitudinal direction of the gutter; but does not teach that the rear surface is arranged to face the building when the second leg is attached to the building. It would have been obvious to one of ordinary skill in the art, at the time invention was made, to use the device in different manners in order to support the gutter onto a building, including where the rear surface is arranged to face the building when the second leg is attached to the building, depending on the various shapes of the various buildings and fascia arrangements since the device is for the purpose of mounting to a building.

Regarding claim 9, as best understood, Lasscock teaches the device of claim 7, wherein the gutter retaining clips include projections which extend into the recess and are adapted to cooperate with the inner wall of the gutter so as to retain the gutter to the device.

Regarding claim 11, as best understood, Lasscock teaches the gutter and device of claim 9, wherein said projections are hook-like elements pressed or punched out of the first leg. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 12, as best understood, Lasscock teaches the device of claim 7, further including a plurality of access apertures (holes located above elements 22) in the first leg for providing access to the second leg when it is being attached to the building.

Regarding claim 13, as best understood, Lasscock teaches the device of claim 7, wherein the retaining clips are aligned parallel with respect to a single edge of the mounting device (the clips are parallel to both the longitudinal and latitudinal perimeter edges of the device).

Regarding claim 14, as best understood, Lasscock teaches the device of claim 7, but does not specifically teach that the second leg actually receives fasteners. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to drill fasteners into the body of the second leg in order to securely attach the device to the fascia (10) because a fastener is a known securing mechanism.

Regarding claim 15, as best understood, Lasscock teaches the device of claim 7, wherein the elongated device is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 17, as best understood, Lasscock teaches the gutter and device of claim 37, wherein the second leg of the U-shaped portion is the attachment section.

Regarding claim 21, Lasscock teaches the gutter and device of claim 17, further including a plurality of access apertures (holes located above elements 22) in the first leg for providing access to the second leg when it is being attached to the building.

Regarding claim 23, as best understood, Lasscock teaches the device of claim 17, but does not specifically teach that the second leg actually receives fasteners. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to drill fasteners into the body of the second leg in order to securely attach the device to the fascia (10) because a fastener is a known securing mechanism.

Regarding claim 27, as best understood, Lasscock teaches the device of claim 7, wherein at least two retaining clips (plurality of clips) are able to simultaneously engage the gutter to retain the gutter to the mounting device (col. 2, lines 11-18).

Regarding claim 31, as best understood, Lasscock teaches the device of claim 12, wherein the access apertures are provided in the first leg in an alternating arrangement with the retaining clips (from the top of the device down, the apertures and clips are in an alternating arrangement).

Regarding claim 33, as best understood, Lasscock teaches the device of claim 21, wherein the access apertures are provided in the first leg in an alternating arrangement with the retaining clips (from the top of the device down, the apertures and clips are in an alternating arrangement).

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Regarding claim 37, as best understood, Lasscock teaches the device of claim 16, wherein the elongated device body further comprises an attachment section (30) attachable to the building and having a rear surface, the recess being disposed forward of the rear surface so as to allow for locating of the inner wall of the gutter into the recess into the installed position when the attachment section is attached to the building, but does not teach that the rear surface is arranged to face the building when the attachment section is attached to the building. It would have been obvious to one of ordinary skill in the art, at the time invention was made, to use the device in different manners in order to support the gutter onto a building, including where the rear surface is arranged to face the building when the attachment section is attached to the building, depending on the various shapes of the various buildings and fascia arrangements since the device is for the purpose of mounting to a building.

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 7, 9, 11-15, 17, 21, 23, 27, 31, 33 and 37 have been considered but are moot in view of the new ground(s) of rejection.

15. Regarding claims 16, 18-20, 22, 24-26, 28, 29 and 34-36, applicant states that the device is not engage the inner wall of the gutter to retain the gutter to the clip. The Examiner respectfully disagrees. As set forth above, the inner wall of the gutter (36) is retained and held in place by the pressure of the first (21) and second (28) legs of the clip. The first and second legs exert pressure on the inner wall of the gutter, thereby "engaging" the inner wall of the gutter. The claims do not require a direct connection between the inner wall of the gutter and the legs of the clip.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NKEISHA SMITH whose telephone number is (571)272-5781. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrell McKinnon can be reached on (571) 272-4797. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NKEISHA J. SMITH/  
Primary Examiner, Art Unit 3632

May 20, 2011